

## REMARKS

### **SUMMARY**

In the Office Action dated April 9, 2004, claims 1-14 were rejected under 35 U.S.C. § 101, claims 1-2, 7-16, 19-23 and 26-28 were rejected under 35 U.S.C. § 102, and claims 3-6, 17-18 and 24-25 were rejected under 35 U.S.C. § 103.

Applicant has amended claims 1 and 9-10. No new matter has been entered. Reconsideration of the pending claims is respectfully requested in light of this amendment and the following remarks.

### **IN THE CLAIMS**

#### Rejections Under 35 U.S.C. § 101

Claims 1-14 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, the Office Action states that for a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. Further the Office Action states that claim 1 recites an abstract idea that can be performed in the mind of the user or with the use of paper and pencil, thus falling outside the realm of technological arts and patentable subject matter.

Applicant respectfully disagrees with this characterization and respectfully reminds Examiner that an examiner has the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under § 101. See MPEP § 2106(II)(A).

Nevertheless, in an effort to expedite prosecution, Applicant has elected to clarify the language of claim 1 to further demonstrate application in the advancement of the

technological arts. Applicant submits that such amendment is not intended to be narrowing and has not been made to overcome any rejections based upon the prior art.

Applicant's amended claim 1 now reads:

In an electronic delivery address service, a method comprising:

receiving by the delivery address service, an electronic subscription from a subscriber, the received subscription including a mailing address of the subscriber;

in response, the delivery address service electronically providing the subscriber with a substitute delivery address;

receiving by the delivery address service, an electronic notification of either a request to deliver or an arrival of a purchased good, as a result of the substitute delivery address being used in an online purchase of the good; and

intervening by the delivery address service to facilitate delivery of the purchased good to the subscriber, using the provided mailing address of the subscriber.

In particular, claim 1 now specifies an electronic delivery address service where the delivery address service electronically provides a subscriber with a substitute delivery address in response to a received electronic subscription. Moreover, the delivery address service receives an electronic notification of either a request to deliver or an arrival of a purchased good as a result of the substitute delivery address being used in an online purchase of the good and intervenes to facilitate delivery of the purchased good to the subscriber using the provided mailing address of the subscriber. Applicant submits that taken together, these amendments further clarify that the method of claim 1 facilitates the advancement of the technological arts, specifically online shopping by providing the manipulated electronic structure used to carry the claimed method out. As such, Applicant submits that claim 1 contains appropriate subject matter under § 101 and requests that the rejection under § 101 be removed.

Claims 2-14 are also rejected under § 101 as being dependent on a rejected claim. Due at least in part upon their dependency on claim 1, Applicant further submits that claims 2-14 comply with § 101 and requests that the rejection be removed.

Rejections Under 35 U.S.C. § 102(e)

Claims 1-2, 7-16, 19-23 and 26-28 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0013739 to O'Donnell et al. ("O'Donnell").

As described above Claim 1 is directed to a method performed by an electronic delivery address service. The claimed method requires the ***delivery address service*** to accept subscription of service from a subscriber, including the subscriber's mailing address, and to ***provide the subscriber with a substitute delivery address*** (to use for online purchases of goods). The claimed method further requires the ***delivery address service*** to ***receive notification*** of either a delivery request or receipt of the purchased goods, and in response, intervene with the shipment to reroute the purchased goods to the subscriber's mailing address.

Note in particular, in claim 1 the delivery address service is required to provide ***the subscriber*** with a ***substitute delivery address*** (for use by the subscriber to make various online purchases). Further, the delivery address service is required to ***receive a notification*** of a delivery request or receipt of the purchased goods (otherwise, it had no knowledge of the purchases and is unable to intervene).

In contrast, O'Donnell teaches a very different anonymous shipping method. Specifically, O'Donnell teaches the employment of a ***central processing computer***, which is assigned with the responsibility of receiving the order information from the subscriber, and making the purchase for the subscriber, including providing the substitute shipping address information to the goods providers/merchants and the correct shipping address to a shipper/carrier, to allow the shipper/carrier to make the delivery.

However, O'Donnell does not teach providing the substitute delivery address to the subscriber (for the subscriber to use to make online purchases), as this is

unnecessary under O'Donnell, since the central computer places the order for the subscriber, including the provision of the substitute shipping address to the goods provider. Similarly, O'Donnell does not teach having the delivery address service received notification of a request to delivery or receipt of goods, since the central computer by virtue of its placement of the order is aware of the purchase, and by virtue of its provision of the actual delivery address to a shipper/carrier, never receive the purchased goods.

Thus, O'Donnell fails to anticipate at least one of the required limitations of claim

1. Accordingly, the method of claim 1 is patentable over O'Donnell under § 102(e).

Additionally, O'Donnell's system is completely focused on providing anonymity to the purchaser. There is no discussion or consideration given for providing anonymity to the beneficiary of a purchase, that is not be the purchaser himself/herself, in particular, **without** the purchaser becoming a subscriber of the anonymity service (see e.g. dependent claim 14). The invention as claimed enables such novel anonymity (i.e. to the beneficiary of a purchase without participation of the purchaser) to be provided. Applicant submits, due to the absence of any related teachings or suggestions, one of ordinary skill would not be motivated to modify O'Donnell to arrive at the invention as claimed to provide such novelty anonymity service. Accordingly, the method of claim 1 is further patentable over O'Donnell even under § 103(a).

Claims 15 and 22 are similarly rejected under § 102(e) as being anticipated by O'Donnell. Applicant submits that claims 15 and 22, which are directed to a storage medium and an apparatus, contain similar elements to the method of claim 1. In particular, each of claims 15 and 22 recites that the subscriber is provided with the substitute delivery address, and the delivery address service receives a notification of a delivery request or receipt of the purchased goods. Thus, for at least the reasons set

forth above with respect to claim 1, Applicant submits that claims 15 and 22 are likewise in proper form for allowance.

Claims 2, 7-14, 16, 19-21, 23, and 26-28 depend from claims 1, 15 and 22. Due at least in part on their dependency, Applicant submits that claims 2, 7-14, 16, 19-21, 23, and 26-28 are also in proper form for allowance.

Rejections Under 35 U.S.C. § 103(a)

Claims 3-6, 17-18, and 24-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Donnell in view of U.S. Patent Application No. 6,336,100 issued to Yamada ("Yamada").

In particular, Yamada is relied upon for teaching that the mailboxes and the mailbox are proximately located with the mailing address of the subscriber. Whether or not Yamada teaches that which it is said to teach, Applicant submits that Yamada does not cure the above mentioned deficiencies of O'Donnell as applied to at least claims 1, 15, and 22. In particular, at the very least Yamada does not teach or otherwise suggest that a delivery address service provides a subscriber with a substitute delivery address, and be equipped to receive and respond to a notification of a delivery request or receipt of a purchased good.

Therefore based at least in part on their dependencies of claims 1, 15 and 22, Applicant submits that claims 3-6, 17-18 and 24-25 are patentable over O'Donnell, whether alone or in combination with Yamada, and thus are in proper form for allowance.

CONCLUSION

Applicant has further endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Any claim amendments which are not

specifically discussed in the above remarks have not been made for patentability purposes. In addition, such amendments do not narrow the scope of the claims. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language.

In light of the above amendments and remarks, Applicant submits claims 1-28 are in condition of allowance. Early issuance of Notice of Allowance is respectfully requested.

The Commissioner is hereby authorized to charge shortages or credit overpayments to Deposit Account No. 500393.

Respectfully submitted,  
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